

REMARKS

1 The Examiner objected to the drawings under 37 C.F.R. 1.83(a) for the reason
that at least one of the plurality of teeth is not shown on both sides of the lower jaw, as
initially claimed in claim 5. Claim 5 has been cancelled. Applicant now believes the
5 drawings to be in condition for allowance.

 The Examiner rejected claims 1-12 under 35 USC §102(b) as being anticipated
by U.S. Patent No. 3,482,614 (Jordan) or U.S. Patent No. 3,550,655 (Murphy).
Applicant respectfully disagrees with the Examiner's rejections. However, in an effort to
expedite the present application, claims 2, 3, 5, 11 and 12 have been cancelled. More
10 importantly, claim 1 has been amended to specifically include the limitations that: a) the
lower jaw is comprised of first and second side members that are laterally spaced from
one another to define an opening in the upper edge portion of the lower jaw that is
shaped and sized to receive at least a portion of the cutting edge of the upper jaw when
15 the shear is in said closed position; and b) the at least one tooth extends generally
upwardly from only one of the first side member or the second side member of the lower
jaw. The prior art fails to teach or otherwise suggest any such structural arrangement.

 The aforementioned structural arrangement provides a significant advantage over
prior art shears. Figure 3 depicts the shear in a generally horizontal position. The teeth
20 36 are coupled with only the first side member 18 of the lower jaw 14. In the
embodiment depicted, the first side member 18 is positioned below the second side
member 20 and the upper jaw 12, when it moves to its closed position. After a review of
the Detailed Description and Figure 3, the significant advantage will become apparent to
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1 those of skill in the art. The scissoring action of the upper jaw 12 over the teeth 36 will
tend to push the tree being cut slightly in the direction of the path that the upper jaw 12
moves, both away from the at least one actuator and in a definite direction. Without the
teeth 36, or when teeth 36 are positioned on both the first and second side members 18
and 20, the cut portion of the tree will fall in a less predictable direction since the
direction will become more heavily dependant on sheer angle, shape and mass-
dispersal of the tree, pitch of the operating surface, etc. Not only will the forced felling
of the tree in the direction of blade travel help protect components of the shear, it will
greatly increase the safety of individuals and property around the tree being felled.
Accordingly, claim 1 is believed to be patentably distinct from the prior art. Claims 4
and 6-10 each ultimately depend from amended claim 1 and are believed to be
allowable for at least the reasons set forth herein with respect to claim 1.

The Examiner rejected claims 1-12 under 35 USC §103(a) as being unpatentable
over either Jordan or Murphy in further view of U.S. Patent No. 4,908,946 (Labounty).
Specifically, the Examiner states that the Labounty device has each of the structural
limitations set forth within claims 1-12 except the one or more teeth along the lower jaw.
The Examiner states that, based on the Jordan or Murphy Patents, it would have been
obvious to a person having ordinary skill in the art to provide the Labounty device with
one or more teeth along the lower jaw. Applicant respectfully disagrees with the
Examiner's rejections. However, as discussed in greater detail hereinabove, applicant
has cancelled claims 2, 3, 5, 11 and 12 and amended claim 1. The amendments to

claim 1 are not suggested or otherwise disclosed anywhere in the prior art and are
1 believed to render claim 1 allowable.

Obviousness can only be established by combining or modifying the teachings of
the prior art to produce a claimed invention where there is some teaching, suggestion,
5 or motivation to do so, found either explicitly or implicitly in the references themselves or
in the knowledge generally available to one of ordinary skill in the art. "The test for an
implicit showing is what the combined teachings, common knowledge of one of ordinary
skill in the art, and the nature of the problem to be solved as a whole would have
suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 55
10 USQP2d 1313 (Fed. Cir. 2000). In the Kotzab case, the Federal Circuit decided that the
control of multiple valves by a single sensor, rather than by multiple sensors, was a
simple concept. However, the Federal Circuit held that there was no finding as to the
specific understanding or principle within the knowledge of the skilled artisan that
15 would have provided the motivation to use a single sensor as the system to control
more than one valve. Id. Similarly, the applicant's improvement is a simple concept
that only becomes apparent to those of skill in the art after a complete review of the
applicant's specification and Figures.

The mere fact that the references can be modified does not render the resulting
20 modified structure obvious unless the prior art also suggests the desirability of the
combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). "A
statement that modifications of the prior art meet the claimed invention and would have
been 'well within the ordinary skill in the art at the time the claimed invention was made
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1 because the references relied upon teach that all aspects of the claimed invention were
individually known in the art' is not sufficient to establish a *prima facie* case of
obviousness without some objective reason to combine the teachings of the
references." Ex parte Leavengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).
5 The combined teachings of the cited references do not provide a sufficient body of
material to render the subject claims obvious to a person of ordinary skill in the art, even
in view of the presumed knowledge held by such a person of skill in the art.

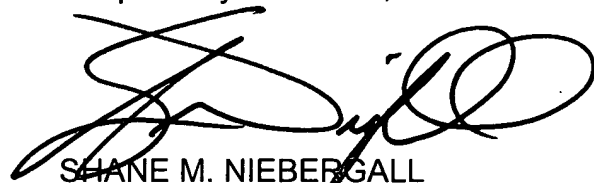
10 In determining the difference between the prior art and the claims, the question
under 35 U.S.C. § 103 is not whether the differences themselves would have been
obvious, but whether the claimed invention as a whole would have been obvious.
Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983). A
prior art reference and the claimed invention must be considered in their entireties.
Distilling an invention down the "gist" or "thrust" of an invention disregards the
15 requirement of analyzing the subject matter "as a whole." W.L. Gore & Associates, Inc.
v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *Cert. denied*, 469 U.S.
851 (1984).

20 New claim 13 has been added, which claims the method of using the combination
of claim 8 to fell a tree. Claim 13 is believed to be allowable for numerous reasons,
some of which include its dependence on claims 8 and 1. Another reason for claim 13's
allowability is base in the limitation that the shear is positioned to be generally horizontal
and so that the "upper jaw may be moved to said closed position in a right-to-left
25 manner". This may seem trivial at first blush. However, the prior art fails to show a

1 tree-felling device in this particular configuration. The configuration is important, in part,
then the system is used (according to the method claimed) in the Northern Hemisphere,
due to the Coriolis Effect. The Coriolis Effect alters the paths of moving objects on
Earth. Everything from jets to ships to bowling balls and even trees being felled are
5 affected, even if ever so slightly, by the Coriolis Effect. With the teeth positioned on the
lower jaw and the upper jaw moving from right to left in a generally horizontal position,
the tree will experience a slight counterclockwise rotational effect from. This will be
aparent to those of skill in the art upon a review of the Figures and the specification.
Accordingly, the claimed structural arrangement and use are able to use the slight
10 forces of the Coriolis Effect in felling the tree. Accordingly, the Examiner is respectfully
requested to consider claim 13 and allow the same.

No fees or extensions of time are believed to be due in connection with this
amendment; however, please consider this a request for any extension inadvertently
15 omitted, and charge any additional fees to Deposit Account No. 502093.

Respectfully submitted,

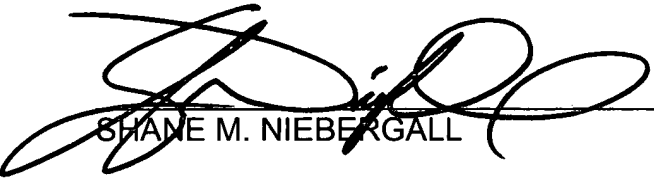


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CERTIFICATE OF MAILING

I hereby certify that the original of this AMENDMENT for WARREN D. GREGORY, JR., Serial No. 10/774,740, was mailed by first class mail, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 9th day of November, 2005.


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